

REMARKS

This responds to the Office Action mailed on September 6, 2007.

In the this response, no claims are amended, no claims are canceled, and no claims are added. Claims 1-10, 13-15, and 33-34 are pending and subject to examination on the merits.

Interview Summary

Applicant gratefully acknowledges a telephonic interview on August 30, 2007 between its patent counsel in this matter, Eduardo Drake, and Examiner William Bashore. In the interview, Examiner Bashore proposed an amendment to place the application in condition for allowance. Specifically, the Examiner proposed that canceling claims 33, 34, and 10, amending claim 9 to include the subject matter of claim 10, and amending claim 13 to specify "storage" medium would make the application allowable. The Examiner noted a potential Section 101 with claim 13, which recites a system comprising various means elements. Applicant noted that as a system the claim was believed to recite statutory subject matter, and moreover, that the recited means elements were intended to be construed under 35 U.S.C. § 112, ¶ 6, and as such, each incorporated the relevant structure described in the specification and equivalents thereof for achieving the recited function. Applicant agreed to allow an Examiner's Amendment pursuant to the Examiner's proposal and the Examiner noted that he would review the Section 101 concern regarding claim 13 and call back if there was a real issue.

§101 Rejection of the Claims

Claim 14 was rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Applicant respectfully traverses this rejection.

The Applicant respectfully submits that 35 U.S.C. § 112, ¶ 6 permits the recitation of a claim limitation as a means for performing a function, without the recital of structure, and such limitation shall be construed to cover the corresponding structure in the specification and equivalents thereof. The Applicant further respectfully submits that the claims, in particular as originally filed, are part and parcel of the specification. The Applicant further respectfully

submits that at least claim 15, which is dependent on claim 14, discloses corresponding structure for the means for receiving, the means for generating, the means for determining, and the means for selecting recited in claim 14.¹ This corresponding structure, which is linked to the means clauses by claim 15, includes software modules, one or more computer processors, various parts of a mainframe computer, a SUN Ultra 4000 Server, an IBM compatible personal computer, and equivalents thereof. The Applicant further respectfully submits that claim 14 may also include other equivalents based on other structures disclosed throughout the specification.

The Office Action particularly contends that the preamble of claim 14, that is "A system comprising", is non-statutory because there does not appear to be any hardware recited in the claim. The Office Action goes on to state that the claim is interpreted as software only, and is therefore deemed non-statutory. As pointed out in the previous paragraph, claim 14 recites hardware.

For at least the above-identified reasons, the Applicant respectfully submits that the rejection of claim 14 under 35 U.S.C. § 101 is in error, and the Applicant respectfully requests the withdrawal of that rejection.

§103 Rejection of the Claims

Claims 9 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wanderski et al. (U.S. Patent No. 6,519,617) in view of Hull et al. (U.S. Patent No. 6,687,404).

The Examiner indicated during the interview of August 30, 2007, and the current Office Action reiterates, that claim 10 would be allowable if it was rewritten to include all the limitations of the independent claim from which it depends and any intervening claim. The Applicant has incorporated all the limitations of claim 10 into claim 9 and canceled claim 10. The Applicant respectfully submits that claim 9 is now in a condition for allowance.

The Office Action rejected claim 14 along the same rationale as claim 1 contending that it reflects a system comprising computer readable instructions used for performing the methods as recited in claim 1. However, the Applicant respectfully points out that claim 1 no longer stands rejected, but rather has been allowed. The Applicant respectfully submits then that the rejection of claim 14, which is substantially similar to claim 1 as pointed out in the Office

¹ Claims 14 and 15 remain pending as originally filed.

Action's rejection of claim 14, was an oversight by the Examiner. The Applicant respectfully submits that claim 14, like claim 1, is in a condition for allowance.

Claim 33 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Wanderski et al. (U.S. Patent No. 6,519,617) in view of Yamakawa et al. (U.S. Patent No. 5,907,851). The Applicant respectfully traverses this rejection.

In the rejection of claim 33, the Office Action specifically conceded that Wanderski omits a teaching of "providing a set of two or more DTDs, and selecting one for conversion," but asserted that Yamakawa "teaches document conversion utilizing preparation of a plurality of ... DTDs for switching and development of one or more DTDs." (Yamakawa, column 22, lines 22-32, Figure 67). Further, the Office Action contended that it would have been obvious to apply Yamakawa to Wanderski to provide "the benefit of predefined DTD selection for eventual adherence to various established standards."

However, the proposed motivation is not applicable to Wanderski. Wanderski reports "a method, system, and computer-readable code for ... creating an Extensible Markup Language, or XML dialect ... and then dynamically generating a document type definition for this XML dialect." (Column 1, lines 16-23). As such, it appears that one of skill would view the provision and selection of a DTD from multiple DTDs to be contrary to the teachings of Wanderski. Wanderski reports dynamic generation of customized DTDs. (See MPEP, § 2143.02, Part VI, When proposed modification of prior art changes the principle of operation of the prior art (*i.e.*, it is contrary), a *prima facie* case of obviousness has not be made.) Consequently, Wanderski and Yamakawa are not properly combinable, and as such, one of skill in the art considering the Wanderski and Yamakawa references at the time that the presently claimed subject matter was made would not have been led to come up with the presently claimed subject matter. Consequently, the Applicant respectfully requests the withdrawal of the rejection of claim 33.

Moreover, the rationale provided by the Office Action as to why one of skill in the art would have been motivated to combine the Wanderski and Yamakawa references is insufficient. The Supreme Court in *KSR* stated that it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine elements in the way that the

claimed subject matter does.² However, such a general statement as in the current Office Action that one would be motivated to combine Wanderski and Yamakawa so as to provide “the benefit of predefined DTD selection for eventual adherence to various established standards” is an insufficient rationale.³ Several questions exist, such as what are these various standards, and how would any purported combination of Wanderski and Yamakawa assist in the adherence to such standards. The Office Action completely lacks any substantial analysis, and as such, fails to meet the standards as set out in *KSR*, and consequently fails to establish a *prima facie* case of obviousness.

Claim 34 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Wanderski et al. (U.S. Patent No. 6,519,617). The Applicant respectfully traverses this rejection.

Claim 34 recites a computer-implemented method of receiving a first document for disambiguation, wherein this first document includes a first and second portion. Each portion of this document is ambiguated. The first portion of the document is disambiguated, but the second portion of the document is not disambiguated. A second document is output; the second document includes the disambiguated portion of the first document and the second portion of the first document.

The Office Action cites column 4, lines 25-42 and Col. 11, lines 60-67 of Wanderski in its rejection of claim 34 under 103(a). However, column 4, lines 25-42 concern only the transformation of an XML document into a new XML dialect, and column 11, lines 60-67 concern only a DTD that corresponds to modified tags in a Document Object Model (DOM) tree. Wanderski fails to disclose that only a portion of the XML document is transformed into the new XML dialect, or that the XML dialect document includes a disambiguated first portion and a second portion of the document that is not disambiguated. That is, Wanderski does not disclose at least partial disambiguation as recited in claim 34.

² *KSR International Co. v. Teleflex Inc. et al.*, slip opinion, (2006), p. 15.

³ See also *In re Lee*, 277 F.3d 1338, 1342-44 (Fed. Cir. 2002) (There must be objective evidence and specific factual findings with respect to the motivation to combine references). See also *Ecolchem v. Southern California Edison Co.*, 277 F.3d 1361, 1372 (Fed. Cir. 2002) (broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence of obviousness).

Moreover, as pointed out by the Applicant in previous correspondence with the Patent Office in this matter,⁴ a shortcoming of prior art markup converters is that they follow an all-or-nothing approach to markup, thus preventing these converters from outputting a document with both marked and unmarked portions. Wanderski suffers from this same deficiency. Consequently, the Applicant stands by its assertion that prior art markup converters follow an all-or-nothing approach to markup, and respectfully requests that the Examiner come forward with evidence to the contrary to support his contention in the Office Action that such was known by skilled artisans at the time that the invention was made.

The Applicant respectfully submits that the rejection of claim 34 under 35 U.S.C. § 103(a) is improper, and respectfully requests the withdrawal of the rejection.

Allowable Subject Matter

The Applicant gratefully acknowledges the allowance of claims 1-8, 13, and 15.

Reservation of Rights

In the interest of clarity and brevity, Applicant may not have equally addressed every assertion made in the Office Action, however, this does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of

⁴ See e.g., Applicant's Pre-Appeal Brief Request for Review, April 5, 2007, p. 5.

the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 371-2140 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date

December 4, 2007

By

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 12/19/07 day of December, 2007. 5PM DAY OF DECEMBER, 2007.

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